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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/901,692	07/28/1997	AKIRA KAMAKURA	1095.1076/JD	9430

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EXAMINER

KAZIMI, HANI M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/901,692

Applicant(s)

KAMAKURA ET AL

Examiner

Hani Kazimi

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on July 6, 2004. Claims 1 and 3-10 are pending in this application. The rejections cited are as stated below:

Status of Claims

2. Of the original Claims 1-10, claims 1, and 2 have been amended by Applicants' amendment filed on March 25, 1999. The same amendment has added claims 11-14. In the amendment filed on March 10, 2000, claims 2, and 13 have been canceled, and claims 1, 11, 12, and 14 have been amended. In the amendment filed on August 10, 2000, claim 3 has been amended. In the amendment filed on February 26, 2001, claim 14 has been amended. In the amendment filed on October 23, 2001, claim 1 has been amended, and claims 15, and 16 have been added. In the amendment filed on September 4, 2002, claims 1, 3, 4, 6-12, 14, and 15 have been amended, and claims 17-19 have been added. Claims 1, and 7 have been amended, and claims 11-19 have been canceled in the amendment filed on July 6, 2004. Therefore, claims 1 and 3-10 are under prosecution in this application.

Response to Applicant's amendment

3. The Examiner acknowledges Applicants' arguments in the remarks section of the

amendment filed on July 6, 2004, and therefore withdraws the previous office action's objection to the specification and the rejection under 35 U.S.C. ' 112, first paragraph.

In response to Applicant's statement regarding the delay of processing the RCE filed on July 15, 2002, and the Patent Term Adjustment, Applicant is respectfully advised that patent term adjustment is not determined until the time a notice of allowance is issued. Applicant's remaining traversals are discussed below.

Claim Rejections – 35 U.S.C. 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

6. Claims 1 and 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. US Patent No. 5,794,207 (hereinafter "Walker '207") in view of Walker et al. US Patent No. 5,884,270 (hereinafter "Walker '270").

Claims 1 and 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. US Patent No. 5,794,207 (hereinafter "Walker '207") in view of Walker et al. US Patent No. 5,884,270 (hereinafter "Walker '270") as discussed in paragraph 12 of the previous office action. Further:

Walker '207, teaches the added claimed limitations where the posting unit posts the non-binding market information while withholding from the dealers a portion of the personal information of the consumer necessary for a dealer to identify and contact the consumer about the viewed market information (column 13, line 1-53, column 15, line 46 thru column 16, line 11, column 17, lines 8-26, and column 27, lines 20-36), and the dealer can use the portion of the consumer's personal information to personally contact the consumer about the viewed market information (column 13, line 1-53, and column 19, lines 55-60);

an information extracting unit extracting from the registered personal information, personal information to be disclosed to the dealer when access approval is confirmed (fig. 2, element 255, and column 13, lines 1-53); and

a pickup processing unit permitting the dealer to pickup the personal information extracted by the information extracting unit (column 19, lines 55-60).

Response to Arguments

7. Applicant's arguments filed July 6, 2004 have been fully considered but they are not persuasive. In the remarks, the Applicant argues in substance that;

"The rejection improperly reads limitations from the specification into the claims. At page 6, lines 12-14, the rejection states that "therefore, the cited portions of Walker '207 (column 13, lines 1-53, and column 19, lines 55-60) teaches the claims limitation of means ' for acquiring personal information of the consumer necessary for the dealer to access the consumer' as recited in claim 1." "Although the PTO had 1 year and 9 months to respond to Applicant's Amendment, the rejection is directed to an outdated version of the claims. Based on the means-for assumption."

In response to the above argument;

The previous office action addressed the last version of the claims submitted by Applicant; the section (page 6, lines 12-14) that the Applicant refers to in the previous office action was in the response to arguments. A means plus function claim is interpreted in light of the specification to only find what that "means" is according to the specification. The rejection didn't read limitations from the specification into the claims. The examiner refers to previous office actions only for short; any newly added limitations are always addressed.

In the previous office action the Examiner relied on Applicant's specification in the response to arguments section to show the type of personal information that are registered, as indicated in italic below.

"Walker '207 clearly teaches the step of "acquiring personal information of the consumer necessary for the dealer to access the consumer" (column 19, lines 55-60). Walker '207 (column 19, lines 55-60), clearly discloses another embodiment wherein the buyer and seller can communicate with each other directly. In rejecting this feature,

the Examiner cited (column 13, lines 1-53) of Walker '207 to show the data storage devices storing information pertaining to the buyer and seller including personal information, contact information, and electronic mail and URL addresses. Also, (column 19, lines 55-60) was cited for rejecting the same feature to show the direct communication between the buyer and seller. In order for the one party to communicate directly with the other party, some of the personal information disclosed in (column 13, lines 1-53) has to be known to the other party. In addition, *Applicant's specification (page 10, lines 4-7,) discloses the type of personal information registered in the personal information registration section, "such as demographic information and electronic mail address" that is necessary for the dealer to access the consumer*.

Applicant's remaining arguments such as claim 3 have been addressed in the above rejection and in previous office actions.

Conclusion

8. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3624

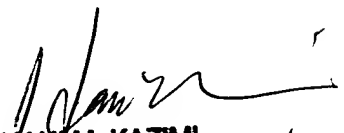
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.


HANI M. KAZIMI
PRIMARY EXAMINER
Art Unit 3624

November 15, 2004